

REMARKS

By way of review, the January Action included notice to the Applicant that there had been a change in assigned art unit and examiner. The application as filed on 11/8/01 was originally classified in Art Unit 1615 and assigned to Examiner Young (at least through 9/22/2004). Primary Examiner James M. Spear was listed as the examiner for Art Unit 1618 on a non-final office action dated 8/10/2005. Most recently, the application has been re-assigned to the original grouping, (i.e., Art Unit 1615), and the application is presently assigned to Examiner Silverman.

In a previous office action dated August 10, 2005 (the "August Action"), Primary Examiner Spear had indicated that claims 6-10, 14, 18-24, and 28 "are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." This language can be found in the MPEP §707.07(j) as Form Paragraph 7.43, and is to be used in situations "[w]here the examiner is satisfied that the prior art has been fully developed and some of the claims are clearly allowable". Furthermore, the use of the Form Paragraph 7.43 "may be used to indicate allowable subject matter" of claims that are otherwise objected to.

In reliance upon Primary Examiner Spear's indication of conditionally allowable subject matter, Applicant's response amended claims 6-9, 14, 18-23, and 28, converting such claims into independent claims as suggested--that is, including all of the limitations of the respective base claims and any intervening claims. Additionally, to overcome the rejections to the balance of the claims, Applicant cancelled claims 1-5, 11-13, 15-17, 25-27 and 29-32 in order to advance the prosecution, and put the amended claims in condition for allowance.

Following the August Action, the case was passed to a different examiner who issued a new rejection (the January Action) in response to Applicant's reply to Primary Examiner Spear's August Action. Nothing was noted with regard to the previous rejection, or about the ostensibly allowable claims. Furthermore, no new art was cited.

The MPEP gives guidance in §706.04 for a situation where there has been an indication of allowable subject matter, and where there has been previous action by a different examiner:

"Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something. (citing Amgen, Inc. v. Hoechst Marion Roussel, Inc., 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1499-50 (D. Mass. 2001).)"

In the unusual instance that it is necessary to reject a previously allowed claim, the MPEP in §706.04 further provides for the examiner to point out in the office action that the claim now being rejected was previously allowed by using the text from Form Paragraph 7.50:

"The indicated allowability of claim [] is withdrawn in view of the newly discovered reference(s) to [new reference(s)]. Rejection(s) based on the newly cited reference(s) follow."

Form Paragraph 7.50 requires "newly discovered references" for rejecting claims that had been indicated as being allowable subject matter. A review of the IFW for the present application reveals that Examiner Silverman updated the search on 1/4/2006; however no new references were cited, in fact, no new references are listed in either the search notes or the subsequent notice of references cited. The existing five references were cited in the pending case prior to the August Action, and were considered by Primary Examiner Spear.

As a result of the January Action, the pending claims stand rejected by Examiner Silverman, without addressing the previous indication of conditionally allowable claims, and furthermore without addressing the fact that Applicant performed the amendments suggested by Primary Examiner Spear, which seemingly would have converted allowable claims into allowed claims. Further, there was no citation by Examiner Silverman of newly discovered references, nor was there any indication of clear error on the part of Primary Examiner Spear.

Appl'n No. 10/010,304
Request for Reconsideration dated 5/15/2006
Reply to Office Action dated 1/13/2006

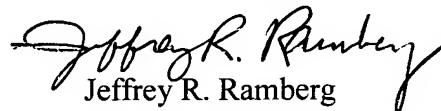
In conclusion, and as stated at MPEP §706.04:

"A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action. Great care should be exercised in authorizing such a rejection. See Ex parte Grier, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923); Ex parte Hay, 1909 C.D. 18, 139 O.G. 197 (Comm'r Pat. 1909)."

There is no indication in the January Action that any of this took place.

Accordingly, Applicant specifically requests that claims 6-10, 14, 18-24 and 28, having been previously identified by Primary Examiner Spear as containing allowable subject matter, be granted a Notice of Allowance, as Applicant respectfully submits that Primary Examiner Spear's objections to those claims were rectified in Applicant's response dated 11/15/05. Alternatively, Applicant requests either indication of clear error by Primary Examiner Spear, or the citation of newly discovered references.

Respectfully submitted,


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